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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,303	07/03/2006	Ko Matsuoka	053121	3598
25225 7590 06/04/2009 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER				
EL-ZOOBI, MARIA				
ART UNIT		PAPER NUMBER		
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06/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,303

Applicant(s)

MATSUOKA, KO

Examiner

MARIA EL-ZOOBI

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/08/2009 have been fully considered but they are not persuasive for the following reasons: Murphy discloses TV (Fig. 1) that receive a program "broadcast" and also having two way communication (abstract), Murphy discloses a "stereo configuration" (Paragraph 0052) and multi channel audio format including mono, stereo (Paragraph 0057). It is well known that in the stereo configuration "connected to the TV" a monaural television audio signal is being generated from the left and right channel signal of the television audio. Murphy also teach that upon receiving an audio message, the message could be sent to a specific channel "left or right" or continue receiving the audio signal and the current message could be "voiced over" (receiving the TV audio on the stereo configuration "which means from the left and right channel" and having the audio message also on the same channels with volume differentiation; Paragraph 0052). Therefore, Examiner maintains the rejection.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US Patent 6,590,602) in view of Murphy (20040250285)

Regarding claim 1: Fernandez discloses, a mobile apparatus comprising a television tuner for receiving a television broadcast, a communication device for performing a telephone communication (Col. 1, lines 56-57, Col. 2, lines 57-65, Col.2, lines 9-11, 22-27, 57-65 and Col. 3, lines 11-12; the reference teaches a digital TV unit that enable receiving a TV programs and having a videoconference with multiple parties simultaneously and this DTV can be implement in a mobile to enable these features) and enable the video conferencing by selecting the participants and activate the video camera and microphone (Col. 4, lines 66-67 through Col. 5, lines 1-2), an audio output device (the speaker Fig. 3, el. 32) and that the display screen may

combine and mix Program display, data, and video conference window (Col. 3, lines 42-47) and audio output signal also generated (Col. 3, lines 52-55), also
Fernandez discloses that the program broadcast is being through channel 6 (Col. 4, lines 38-40) and that the conference is through channel 10 (Col. 5, lines 14-16).

Fernandez does not disclose the audio output device or the audio circuit as claimed.

In similar art of endeavor, Murphy discloses, a system and method for two way communication, wherein one or more set top boxes can conduct a two way communication with other set top boxes , so user can send text , audio and video messages, the set top boxes also include provisions that permit two way communication using video camera and microphones (see Paragraph 0035, 0052, 0059 and Fig. 7- 8).
Murphy also discloses stereo system wherein the audio messages "received from another user" could be sent to the left audio output and the current audio signal would remain active on the right audio output (Paragraph 0052 and also see discussion above).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Fernandez audio system with Murphy teaching to improve the system and yield more predictable results by enabling the user to listen to TV and talk to the calling party simultaneously, so if the user listening to news broadcast he/she will be able to end the phone conversation upon hearing an important event and want to pay a full attention to the detail.

Regarding claim 3, Fernandez in view of Murphy discloses, a sound volume ratio control means for controlling a ratio of sound volumes of the two audio output units in the case of performing the telephone communication at the time of viewing or listening to the television (Murphy: Paragraph 0052).

Regarding claim 4, Fernandez in view of Murphy discloses, a setting means used by a user for setting the sound volume ratio (Murphy: Paragraph 0052).

Regarding claim 5, Fernandez in view of Murphy discloses, wherein the sound volume ratio control means controls the sound volume ratio so that the sound volume of the telephone-received audio is higher than the sound volume of the television audio (Murphy: Paragraph 0052).

Regarding claim 6, Fernandez in view of Murphy discloses, a display device for displaying a television image and a telephone-received image and a display control means for displaying both of the television image and the telephone- received image on the display device in the case of performing the telephone communication at the time of viewing / listening to the television (Fernandez: Fig. 4 and Col. 3, lines 45-56).

Regarding claim 7, Fernandez in view of Murphy discloses, the display control means window-displays one of the television image and the telephone-received image in a displayed image of the other (Fernandez: Fig. 4 and Col. 3, lines 45-56).

Regarding claim 8, Fernandez in view of Murphy, discloses the display control means divides a display screen into two regions and displays the television image in one of the divided display regions and the telephone-received image in the other region (Fernandez: Col. 3, lines 43-64).

Regarding claim 9, Fernandez in view of Murphy discloses, a setting means used by the user for setting sizes and display positions of the television image and the telephone received image displayed on the display device (Murphy: Paragraph 0053).

Regarding claim 10, Fernandez in view of Murphy discloses, wherein the audio output device is a stereo configuration (Murphy: Paragraph 0018). Fernandez in view of Murphy does not explicitly teach that the audio output device is an earphone or headphone. However, using headphones with a stereo configuration is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Fernandez in view of Murphy to use headphones in the stereo system so to give the user privacy when they receive a call.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US Patent 6,590,602) in view of Murphy (20040250285) and further in view of Eves (WO Publication 01/97560).

Regarding claim 2, Fernandez in view of Murphy discloses, outputting the TV audio and the telephone audio on a different output units (see claim 1 explanation). Fernandez in view of Murphy discloses RCA connectors to accommodate any desired multi-channel audio format including mono, stereo and Dolby surround (Paragraph 0052 and 0057) this connector is used by the user to output the audio in the preferred way for the user.

Fernandez in view of Murphy does not explicitly disclose a setting means for setting which of the audio output units is used for outputting the television audio and the telephone-received audio in the case of performing the telephone communication at the time of viewing or listening to the television.

In similar art of endeavor Eves discloses an audio system that includes first and second audio signals and left and right audio output devices. The stereophonic sounds made into monaural sounds and under the control of a control unit will send to left audio output and that the telephone audio to the right audio output (Pg. 5, lines 1-16).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Fernandez in view of Murphy system with Eves teaching, in order to give the user the ability to choose the preferred channel to output the telephone audio on.

Claim Objections

6. Claim 10 is objected to because of the following informalities: all the letters are in capital letter. Appropriate correction is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIA EL-ZOBI whose telephone number is (571)270-3434. The examiner can normally be reached on Monday-Friday (8AM-5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. E./
Examiner, Art Unit 2614
/CURTIS KUNTZ/
Supervisory Patent Examiner, Art Unit 2614